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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/776,786	05/01/97	BARKATS	M ST94065-US

HM12/1117  
FINNEGAN, HENDERSON, FARABOW, GARRETT AND  
L.L.P.  
1300 I STREET, N.W.  
WASHINGTON DC 20005-3315

EXAMINER

PRIEBE, S

ART UNIT	PAPER NUMBER
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1632

*26*

DATE MAILED:

11/17/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Advisory Action

Application No.  
08/776,786

Applicant(s)

Barkats et al.

Examiner  
Scott D. Priebe, Ph.D.

Group Art Unit  
1632



## THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 4 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Oct 27, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☐ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
  - ☐ will not be entered because:
    - ☐ they raise new issues that would require further consideration and/or search. (See note below).
    - ☐ they raise the issue of new matter. (See note below).
    - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
    - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

- ☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
see attachment

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: none

Claims objected to: none

Claims rejected: 27, 34-36, 38, 40, 41, and 48-50

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Other

SCOTT D. PRIEBE, PH.D.  
PRIMARY EXAMINER  
ART UNIT 1632

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**Attachment to the Advisory Action**

Applicant's reliance on *In re O'Farrell*, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) is wholly misplaced. At the time the instant invention was made, the performance characteristics of expression vectors, including adenoviral vectors, for expression of cloned DNA, such as that of Mullenbach et al., were well understood and predictable. There is no evidence of record that one of ordinary skill in the art would not have fully expected the incorporation of the glutathione peroxidase cDNA of Mullenbach et al. into the adenoviral expression vector of either Kahn et al. or McClelland et al. to result in expression of the cDNA and production of glutathione peroxidase. This is neither a situation requiring trial and error testing in an absence of guidance as to what combinations would have been expected to be successful nor an exploration of a promising, new technology or general approach. While genetic engineering was considered to be a new technology in 1976, it was an established technology in 1995 when the instant invention was made.

Applicant's arguments presented on pages 6-9 regarding *In re Vaeck*, *In re Deuel*, and *in re Dembiczak* are unconvincing for the reasons of record set forth in the Office action of 6/27/00. Each of these Court decisions are misinterpreted and misrepresented as explained previously. In response to applicant's argument that none of the references taught the use of the claimed vectors for treating diseases of the central nervous system, the claims are directed to a product for which Applicant has proposed a new use. The instant claims are not drawn to that new use.

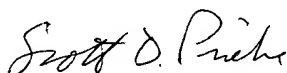
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The basis for Applicant's arguments presented on pages 9-10 is unclear. The instant claims do not exclude the covalent modifications of the adenoviral fiber proteins. Whether Applicant intended it or not, the claimed invention embraces embodiments wherein the adenoviral fiber proteins are modified.

Certain papers related to this application may be submitted to Art Unit 1632 by facsimile transmission. The FAX number is (703) 308-4242 or 305-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310. The examiner can normally be reached on Monday through Friday from 8 AM to 4 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen M. Hauda, can be reached on (703) 305-6608.

Any inquiry concerning administrative, procedural or formal matters relating to this application should be directed to Patent Analyst Patsy Zimmerman whose telephone number is (703) 308-8338. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Scott D. Priebe, Ph.D.  
Primary Examiner  
Technology Center 1600  
Art Unit 1632